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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte BRIAN MARK SHUSTER
11 and STEVEN CHRISTOPHER BUGG
12

13 Appeal 2008-1770
14 Application 09/893,362
15 Technology Center 3600
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18 Oral Hearing Held: February 10, 2009
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24 Before HUBERT C. LORIN, LINDA E. HORNER, and ANTON W.
25 FETTING, Administrative Patent Judges

26
27 ON BEHALF OF THE APPELLANT (by telephone):
28

29 JONATHAN JAECH, ESQUIRE
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35 The above-entitled matter came on for hearing on Tuesday, February 10,
36 2009, at the U.S. Patent and Trademark Office, 600 Dulany Street,
37 Alexandria, Virginia, before Victor Lindsay, Freestate Reporting, Inc.

PROCEEDINGS

JUDGE LORIN: This is Appeal No. 2008-1770.

When you are ready, counsel, you may proceed. You have 20 minutes.

MR. JAECH: Yes, thank you. I'd like to focus on independent claims 1 and 17. These, these are -- one is a method claim, and number 17 is a system claim. Other than that, the limitations are similar. I would just discuss claim 1 with the understanding that these limitations are also in 17 in essentially the same form.

Claim 1 concerns delivering an audio advertisement over the Internet, and the feature that's at issue is this delivering in a format that precludes said at least one user from bypassing playback of any portion of the audio advertisement. The prior art, the first reference, Hamzy, discloses delivering static display ads in some cases with features that delay a user from bypassing the advertisement, and Net-mercial, the second reference discloses delivering audio advertisements in -- with an application frame that includes user controls including a control to exit the advertisement at the user's volition, and Net-mercial also teaches that, that consumers should have complete control of the ad.

So the issue then is therefore whether those two in combination make obvious the limitation of delivering said at least one audio advertisement in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement.

The difficulty in the obviousness argument or I think the weakness in it is that this is an apples to oranges situation in which Hamzy discloses

1 delivering static display ads, and the time considerations that are, that are
2 inherent in, in static display ads are not -- do not carry over to an audio
3 advertisement which is not displayed and is played for, for -- until the file is
4 exhausted and it terminates.

5 It's, it's not -- it's undisputed that Hamzy does not disclose precluding
6 that at least one user from bypassing playback of any portion of said audio
7 advertisement. The argument made by the Examiner is that Hamzy
8 discloses precluding bypass, but the, the -- there is no precluding of bypass
9 of a played ad in Hamzy. It's only displaying an advertisement, a static
10 display ad for a period of time and then terminating the ad and letting the
11 user go on to the next window, or in some cases, requiring the user to find a
12 location to click in the ad, to delay the -- to extend the time that the ad is
13 displayed on the terminal or to answer a question. So Hamzy concerns
14 extending the time of display for a display ad.

15 Net-mercial, the second reference, does not disclose precluding
16 bypass of an audio advertisement, and this is where I think I disagree with
17 the Examiner's character of Hamzy which, although the Examiner is citing,
18 excuse me, the Examiner's characterization of Net-mercial, although the
19 Examiner is citing Hamzy for -- toward the element of bypass preclusion in
20 general, which I argue does not apply, because it, it concerns static display
21 advertisement and not audio ads. The Examiner also argues that Net-mercial
22 discloses bypass preclusion which is not correct, because Net-mercial
23 teaches that the consumer should have complete control of the
24 advertisement, and the only embodiment disclosed in Net-mercial is playing
25 an audio ad in, in a frame, a display frame that includes user controls
26 including an exit control for the, for the user to operate.

1 So we really are left only with Hamzy for the element of bypass
2 preclusion, and then we have to look at whether it be obvious to, to apply
3 elements that were developed and conceived for static display
4 advertisements in the context of an audio advertisement that's played for --
5 until the file is exhausted.

6 So looking at some of the newer cases on obviousness like KSR, it's
7 not a simple element substitution of one known element for another, because
8 you have a change in the context. I don't believe that this is a case where
9 one can simply take part A from reference A and put it into part B.

10 JUDGE FETTING: Counsel.

11 MR. JAECH: Yes.

12 JUDGE FETTING: I -- with Hamzy, it seems to me, correct me if I'm
13 wrong, that Hamzy is at least setting up the, the problem that Hamzy is
14 trying to solve as being essentially equivalent to the problem that you're
15 trying to solve which is getting someone -- getting the customer to view the
16 ad for longer than he might otherwise do so. In fact, at the bottom of
17 column 1, it says the present invention addresses a problem prevalent. In
18 particular, online users often bypass advertisements, for example, by hitting
19 a specific button or a control sequence to bypass the advertisement, and most
20 advertisers would like to extend the time period.

21 It, it seems to me, and I'm not sure from what you've said that you've
22 shown otherwise, that that's almost exactly the same problem that your, that
23 your invention is purporting to solve as well. It would seem that the only
24 difference is that, as you say, Hamzy is working with a visual, and your
25 invention is working with an auditory advertisement. But the problem to be
26 solved seems to be the same in either case.

1 MR. JAECH: Well, I do believe that's a patentable distinction
2 between a viewing and an audio ad in this context, because a display ad is --
3 technically it's a different problem, you know, a banner advertisement or a
4 window that centers an HTML file and just creates a visual display at the
5 client is -- it operates technically differently than an audio advertisement and
6 it, it also -- psychologically it's a different type of advertisement than audio
7 ads.

8 JUDGE FETTING: Well, how --

9 MR. JAECH: Excuse me. Go ahead.

10 JUDGE FETTING: How you implement the preclusion might very
11 well be different, but it would seem that in either case you're still trying to
12 preclude the, the viewer or, or listener from bailing out prematurely and, and
13 your claim really just says precluding. It doesn't specify any particular
14 mechanism for that preclusion. Is that correct?

15 MR. JAECH: That's correct.

16 JUDGE FETTING: And I do notice that Hamzy does speak about
17 disabling part of it during the, during the course of the advertisement. I
18 know that's not necessarily the same implementation as yours, but
19 disablement would certainly appear to be a mechanism that, that would yield
20 precluding doing that which is disabled.

21 MR. JAECH: Disabling, are you referring to the timer function?

22 JUDGE FETTING: Yeah, in the, in the contemplated -- it's column 7,
23 the contemplated embodiment the display is -- the control function which
24 allows the user to proceed is disabled for a predetermined time. So they are
25 disabling the mechanism for allowing the user to proceed which would
26 therefore leave the display in full view, and the auditory corollary would be

1 having the audio being played. And it is certainly true that an audio file is, if
2 nothing else, a timing file, because an audio playback has a certain amount
3 of time, and at the end of that time the audio stops.

4 MR. JAECH: So if I understand you correctly, you're suggesting that
5 there may be a difference in the patentable, in -- a patentable distinction in
6 the details of how the audio advertisement is, is played, but that's not evident
7 in the claims currently at issue?

8 JUDGE FETTING: Well, I mean it -- there certainly may be a
9 distinction in the, the implementation which you referred to in the
10 specification, but of course, that's not in the claim either.

11 MR. JAECH: Right. Well, you know, my, my argument really is as
12 presented in the, the answer, in the reply brief is that these -- this term
13 bypassing playback of any portion of an audio advertisement is different in
14 kind from preventing for a period of time someone from leaving a display
15 ad. I, I understand the technical differences are not explicitly set forth in the,
16 in the claim, but nonetheless they're there, and they're barriers that one of
17 ordinary skill would have to contend with. And when you look at the only
18 other, or excuse me, the other reference, Net-mercial, which does disclose
19 audio advertisement around the same time, their choice is to give the
20 consumer complete control of the ad, and they do --

21 JUDGE FETTING: But they're not speaking about this particular
22 problem, the problem of having the user not bail out prematurely, although
23 to some extent --

24 MR. JAECH: Well, impliedly, impliedly they are, because they, they
25 emphasize the need to give the user complete control of the ad. So that's

1 why, that's why we're making the argument this is an implied teaching away
2 from what the -- what is claimed.

3 JUDGE FETTING: And yet they also have a timer that tells the user
4 how much longer the playback is going to occur which would presumably
5 offset that, encouraging them to continue listening, because they know it's
6 going to come to a stop relatively soon.

7 MR. JAECH: Right, yeah, it's letting them know it's not going to go
8 on for too long.

9 JUDGE FETTING: Right.

10 MR. JAECH: Yeah, that's their, their solution.

11 So I think it's a different medium really between audio and, and a
12 visual display ad and that, that's where the difference lies, and the choice
13 that was -- that's evident in the prior art is given the user control, you know,
14 informing the user that, you know, there's only so much time left but still
15 allowing the user to click out, and what is claimed is precluding the user
16 from leaving an audio ad.

17 JUDGE FETTING: I mean we -- I certainly understand your
18 argument.

19 MR. JAECH: Yeah, and I understand, I understand your position. I
20 think it's just -- I, I think obviousness under 103 is always going to come
21 down to a judgment call. In this case, I think that's a teaching away of the
22 Net-mercial and the difference in the technical context of Hamzy that creates
23 a basis for, for patentability, and that's really the, the nub of the whole issue
24 as I see it.

25 JUDGE FETTING: I have no further questions.

26 MR. JAECH: Okay.

1 JUDGE HORNER: I have one thing. For the benefit of the court
2 reporter, could you state your name, and spell it for the court reporter?

3 MR. JAECH: Yes, certainly. My name is Jonathan,
4 J-o-n-a-t-h-a-n, Jaech, J-a-e-c-h.

5 JUDGE HORNER: Thank you.

6 MR. JAECH: For appellant.

7 JUDGE LORIN: Counsel, do you have any more comments?

8 MR. JAECH: That's all.

9 JUDGE LORIN: Okay, we have no further questions. Thank you.
10 We'll take your comments under advisement, and the hearing is now over.

11 MR. JAECH: Thank you. Bye.

12 (Whereupon, the hearing concluded on February 10, 2009.)